



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In the Patent Application of

Mutsuyoshi ITO

Art Unit: 2827

Serial No. 09/898,068

Examiner: D. Graybill

Filed: July 5, 2001

For: SEMICONDUCTOR PACKAGE AND METHOD FOR PRODUCING THE SAME

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1-28-03

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
Washington, D.C. 20231

Sir:

This is a response to the restriction requirement mailed on December 18, 2002 requiring an election of invention.

The Applicant, through its representatives and attorneys, hereby provisionally elects, with traverse, the invention of Group I, having claims 2, 4, 9-14.

Claims 2, 4 and 7-20 are currently pending in this application, with claims 2, 4, 7, 8 being independent.

The Office Action indicates that restriction is proper because claims 2, 4, 9-14 are drawn to a product and claims 7, 8, 15-20 are drawn to a process.

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Applicant traverses the Restriction Requirement for the following reasons.

"Since requirements for restriction under 35 U.S.C. 121 are discretionary with the Commissioner, it becomes very important that the practice under this section be carefully administered." M.P.E.P. §803.01.

"If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to distinct or independent inventions." M.P.E.P. §803.

Moreover, the claims originally presented and acted upon by the Office on their merits determine the invention elected by an applicant in the application. M.P.E.P. §818.02(a), 8th Edition, August 2001.

The Office Action of June 24, 2002 included an examination of claims 1-8 on the merits. Thus, the claims originally presented and acted upon by the Office on their merits determine the invention elected by an applicant in the application.

In this regard, product claims 1-8 were originally filed with the original specification, with claims 1-4 being drawn to a

product and claims 5-8 being drawn to a method. The product embodied by the originally filed claims 1-4 and the method embodied by the originally filed claims 5-8 were previously acted upon on merits within the Office Action of June 24, 2002.

The amendment filed on September 24, 2002 canceled claims 1 and 3 and added claims 9-14. Claims 9-11 are dependent upon the product of originally filed claim 2, claims 12-14 are dependent upon the product of originally filed claim 4.

The amendment filed on September 24, 2002 canceled claims 5 and 6 and added claims 15-20. Claims 15-17 are dependent upon the method of originally filed claim 7, and claims 18-20 are dependent upon the product of originally filed claim 8.

While claims 2, 4, 7 and 8 have been examined on the merits, the Office Action of December 18, 2002 seeks to make a restriction among claimed features that have already by searched, examined and rejected.

Because, the product and method embodied by the originally filed claims 1-8, and currently embodied within 2, 4 and 7-20 have been previously acted upon on merits within the Office Action of June 24, 2002, the restriction requirement made within the Office Action of December 18, 2002 is respectfully traversed

as improper.

Withdrawal of this restriction requirement is respectfully requested.

Upon allowance of claims 2, 4, 9-14, the rejoinder of the claims withdrawn from consideration by the Office Action mailed on December 18, 2002 along with the full examination and issuance of those claims is additionally requested as required by M.P.E.P §821.04.

An early Action on the merits of this application is respectfully requested. If the Examiner has any comments or suggestions that could place this application in even better form, the Examiner is requested to telephone Brian K. Dutton, Reg. No. 47,255, at 202-955-8753 or the undersigned attorney at the below-listed number.

Respectfully submitted,

B. Dutton 47,255

DATE: January 21, 2003

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